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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/828,460	04/06/2001	William R. Mass	279.308US1	6907

21186 7590 07/28/2003

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EXAMINER

EVANISKO, GEORGE ROBERT

ART UNIT	PAPER NUMBER
	11

3762

DATE MAILED: 07/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/828,460	MASS ET AL. <i>CR</i>
Examiner	Art Unit	
George R Evanisko	3762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
 THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 24 June 2003.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-24 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-24 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/24/03 has been entered.

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification does not provide proper antecedent basis for the reflected RF carrier signal not to load the transmitter of the external device.

### ***Claim Rejections - 35 USC § 112***

Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The subject matter which was not originally described in the specification is the antenna reflecting the RF signal “without loading the transmitter of the external device” in combination with the other elements in the claim. The original specification does not have any negative limitation directed to not loading the transmitter of the external device. In addition, the transmitter will be loaded since there will be a generation of electromotive force in the

transmitter due to the varying magnetic flux reflected by the implanted antenna. Although the loading may be minute, it still is a loading of the transmitter. In addition, it is not "inherent" that the transmitter will not be loaded since the actual physical components used in the transmitter are not described in the specification and/or it can not be determined if the transmitter will or will not be loaded from the specification. Finally, the prior art does show external transmitters being "loaded" and therefore provides possibilities, and proves inherency is not required, that transmitters can be loaded. This rejection is related to new matter.

Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The subject matter which was not described in the specification is the antenna reflecting the RF signal "without loading the transmitter of the external device" in combination with the other elements in the claim. The specification does not contain any limitation to not loading the transmitter of the external device. In addition, the transmitter will be loaded since there will be a generation of electromotive force in the transmitter due to the varying magnetic flux reflected by the implanted antenna. Although the loading may be minute, it still is a loading of the transmitter. In addition, it is not "inherent" that the transmitter will not be loaded since the actual physical components used in the transmitter are not described in the specification and/or it can not be determined if the transmitter will or will not be loaded from the specification. Finally, the prior art does show external transmitters being "loaded" and therefore provides possibilities, and proves inherency is not required, that transmitters can be loaded. This rejection is related to enablement.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, “incorporated as part of the external device” and “implantable device” are vague since they are mixing the claimed subcombination of the telemetry system with the unclaimed combination of the system with the IMD and external device. The external device and IMD have only been functionally recited in the preamble, “...for...IMD...external device”, but the claim body contains an actual structural connection to both IMD and device, “incorporated as part...”. It is unclear if the IMD and external device is being positively recited. In addition, “which reflects the radio-frequency carrier signal” is vague since its claiming a positive connection to the signal and since the signal has not been positively recited (it is suggested to use “for reflecting the...signal”).

In claim 5, “the digital data signal” lacks antecedent basis.

In claim 12, “wherein the implantable device differentially encodes the message data” is vague since claim 4 has the symbol encoder performing the encoding of the message data.

In claims 13-15 and 24, correlation and modulation of “the radio frequency signal” is vague since claim 1 has not positively recited the RF signal. It is suggested to use function terms such as, “is adapted to correlate” or “for modulating”.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George R Evanisko whose telephone number is 703 308-2612. The examiner can normally be reached on M-F 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 703 308-5181. The fax phone numbers for the organization where this application or proceeding is assigned are 703 306-4520 for regular communications and 703 306-4520 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-1148.

*George R Evanisko*  
George R Evanisko  
Primary Examiner  
Art Unit 3762

*7/23/03*

GRE  
July 23, 2003